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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,487	01/28/2000	Andrew Sharp	P11303-US1	2310
27045	7590	06/13/2008	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			NGUYEN, TU X	
			ART UNIT	PAPER NUMBER
			2618	
			MAIL DATE	DELIVERY MODE
			06/13/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW SHARP and MARTIN STUMPERT

Appeal 2007-4142
Application 09/493,487¹
Technology Center 2600

Decided: June 13, 2008

Before MAHSHID D. SAADAT, ROBERT E. NAPPI,
and SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ Application filed January 28, 2000. The real party in interest is Telefonaktiebolaget LM Ericsson.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-38, 40, and 41, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to a communication system with at least two different access systems, such as Universal Mobile Telecommunications System (UMTS) and Global System for Mobile communications (GSM), and handing over communications between different access systems.

Claim 1 is exemplary:

1. A communication system comprising:

a Universal Mobile Telecommunications System (UMTS) wherein the UMTS network is capable of handling a first number of simultaneous communications between a mobile user equipment,

a Global System for a Mobile Communication System (GSM) networks, wherein the GSM network is capable of handling a second number of simultaneous communications between the mobile user equipment and the GSM network, and

wherein at least one of the mobile user equipment and the communication system contain

at least one means for evaluating if a handover between the UMTS material and GSM material should be effectuated and

at least one means for selecting, in the case that the handover is necessary, which communication or communications are handed over and

at least one means for executing the at least one decision.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Rinne	US 2001/0046863 A1	Nov. 29, 2001 (filed May 8, 1998)
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Lintulampi	US 6,377,804 B1	Apr. 23, 2002 (filed Jun. 11, 1998)
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Claims 1-38, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as being obvious over Lintulampi and Rinne.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R.

§ 41.37(c)(1)(vii).²

² Except as will be noted in this opinion, Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Lintulampi and Rinne teach or suggest "simultaneous communications," as claimed.

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the Applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the Applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is the Appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [for obviousness] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d at 988. "To facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences

and creative steps that a person of ordinary skill in the art would employ." *Id.*

The Supreme Court noted that "[i]n many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends." *KSR*, 127 S. Ct. at 1741. "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742. The Court also noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 1742. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1-38, 40, and 41 as being obvious over Lintulampi and Rinne. Reviewing the record before us, we do not agree. In particular, we find that the Appellants have not shown that the Examiner failed to make a prima facie showing of obviousness with respect to claims 1-38, 40, and 41. Appellants failed to meet the burden of overcoming that prima facie showing.

Regarding claim 1, Appellants argue that Lintulampi and Rinne do not teach or suggest the limitation "simultaneous communications," as claimed. (App. Br. 5-7; Reply Br. 6-8.) We do not agree.

The Examiner found that Lintulampi teaches all of limitations of claim 1 except "simultaneous communications," and that Rinne teaches "simultaneous communications." (Final Office Action 2-3; Ans. 4-5.) In particular, Rinne teaches that:

New cellular systems can employ a so-called macrodiversity combining technique related to CDMA [Code Division Multiple Access] systems. This means that on the downlink path a terminal receives user data from at least two base stations and correspondingly, the user data transmitted by the terminal is received by at least two base stations. Then, instead of one, there are two or more active base stations, or a so-called active set. Using macrodiversity combining it is possible to achieve a better quality of data communications as momentary fade-outs and disturbances occurring on a given transmission path can be compensated for by means of data transmitted via a second transmission path.

(Rinne paragraph [0012].) Rinne also teaches that:

Used with a CDMA-type radio network, which facilitates the combining of signals from multiple base stations, or macrodiversity combining, the arrangement according to the

invention is characterised by some special features. Macrodiversity combining employs multiple simultaneous connections, first, between the terminal and base station sectors and, second, between the terminal and individual base stations. On the uplink path the terminal uses one signal and one spread code which is received at several base stations. Alternatively, the terminal may use one signal with several spread codes received at several base stations. The final signal is the result of macrodiversity combination. In the downlink direction, several base stations transmit one and the same signal spread using different spread codes to a terminal that performs the macrodiversity combining. The signal connections that provide sufficient signal strength at agreed power levels belong to the so-called active set.

(Rinne paragraph [0102].)

Appellants argue that the simultaneous *connections* taught by Rinne do not teach or suggest simultaneous *communications*, as claimed. (App. Br. 5-7; Reply Br. 6-8.) We do not agree.

First, Appellants urge "that the definition of 'communication' *as defined in the Applicant's specification* be used to properly determine the meaning of terms used in the claims." (App. Br. 7.) However, the definition of "communication" found in the Specification is quite broad. In particular, the Specification teaches that:

Examples of the communication include telephone calls, faxes, downloading of data or uploading of data (file transfer). *However, the invention is not limited to these examples.* According to the invention, *communication is not limited to any special form of transfer*, neither to information transfer with establishing a connection nor to connectionless information transfer. According to the invention, *communication includes*

connections as well as connectionless transfer of information such as Short Messaging Service (SMS).

(Spec. 2:22-30 (emphasis added).)

We agree with the Examiner (Ans. 4-5) that, using Appellants' own definition of communications found in the Specification, Rinne discloses simultaneous communications. As stated by Appellants, "[p]aragraph 012 [of Rinne] discloses a macro-diversity technique where user data may be received by a terminal from at least two base stations and terminal user data is being transmitted to two base stations." (Reply Br. 7.) This simultaneous reception or transmission of user data taught by Rinne meets the broad definition of communication found in the Specification. In addition, the transmission and reception of spread codes described by paragraph 102 of Rinne also meets the broad definition of communication found in the Specification. Thus, under a reasonable interpretation consistent with the Specification, Rinne teaches simultaneous communications as claimed.

In an argument first raised in the Reply Brief, Appellants further argue that "the widely accepted definitions of 'communications' and 'connections' are also different without the benefit of creative lexicography" (Reply Br. 6) and cite to two dictionaries as evidence in support of this argument. (Reply Br. 6-7.) Although our rules state that a reply brief shall not include new evidence and such new evidence will not be considered,³ we nevertheless find that this argument fails to demonstrate error in the Examiner's rejection.

³ 37 C.F.R. §§ 41.37(c)(1)(vii), 41.41(a)(2).

In particular, citing the Merriam-Webster Online dictionary,⁴ Appellants contend that the term communication may be defined as "an act or instance of transmitting." (Reply Br. 6.) However, as previously discussed, Rinne teaches simultaneously transmitting user data and spread codes. Therefore, Rinne teaches simultaneous communications under this definition as well.

Finally, Appellants argue that there is no motivation to combine the references. (App. Br. 7-9.) We do not agree.

The Examiner articulated a rationale for combining the teachings of Lintulampi and Rinne. (Final Office Action 3.) Also, as the Examiner correctly points out (Ans. 5), both Lintulampi and Rinne are from the same field of endeavor. In particular, Lintulampi relates to a mobile communication system within an area having overlapping coverage of a GSM network and a UMTS network and handovers between the two networks (Lintulampi Abstract; col. 1, ll. 3-10; col. 3, ll. 18-39; col. 4, ll. 48-51; col. 6, ll. 5-8) and Rinne relates to a handover procedure in a cellular system (Rinne paragraph [0001]). The combined teachings of Lintulampi and Rinne present no more than the combination of familiar elements according to known methods, with no unpredictable results. *See KSR*, 127 S. Ct. at 1739. Appellants have not shown, nor do we find, evidence to the contrary.

⁴ Appellants also provide a definition of "Communication Channel" from Newton's Telecom Dictionary to "provide[] further insight" into the term communications. We do not find this definition helpful because, as Appellants admit, the term "communication or communications is not directly defined in Newton's." (Reply Br. 7.)

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). Appellants argue that independent claims 15, 40, and 41 are allowable for the same reasons as independent claim 1. We disagree with that argument for the same reasons discussed with respect to claim 1. Dependent claims 2-14, 16-28, and 31-38 were not argued separately, and fall together with claims 1 and 15, from which they depend.

With respect to dependent claims 29 and 30, Appellants argue that "[a]s noted above, neither Lintulampi nor Rinne disclose 'simultaneous communications'." (Reply Br. 8.) Appellants further argue that Salmivalli, cited by the Examiner in support of taking official notice regarding the specific additional limitations recited by dependent claims 29 and 30 (Ans. 5), does not cure that deficiency. (Reply Br. 8.) We do not agree.

As discussed with respect to independent claims 1, 15, 40, and 41, the combined teachings of Lintulampi and Rinne teach or suggest "simultaneous communications," as claimed. Therefore, we will sustain the rejection of claims 29 and 30 for the reasons discussed with respect to independent claim 15, from which claims 29 and 30 depend.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 29 and 30 under 35 U.S.C. § 103(a).

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-38, 40, and 41 for obviousness under 35 U.S.C. § 103.

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DECISION

The rejection of claims 1-38, 40, and 41 for obviousness under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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